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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte UWE KROHN, ROBERT S. STEWART, and NICHOLAS J. DAVIES

Appeal 2009-003926
Application 10/089,794
Technology Center 2100

Decided: October 28, 2009

Before: HOWARD B. BLANKENSHIP, THU A. DANG, and CAROLYN D. THOMAS, *Administrative Patent Judges.*

DANG, *Administrative Patent Judge.*

DECISION ON APPEAL

I. STATEMENT OF CASE

Appellants appeal the Examiner's final rejection of claims 1-16 under 35 U.S.C. § 134. We have jurisdiction under 35 U.S.C. § 6(b). An Oral Hearing regarding this appeal was conducted on October 8, 2009.

A. INVENTION

According to Appellants, the invention relates to information access and in particular to the use of information retrieval experience of users to enable identification of effective search criteria (Spec. 1, ll. 3-5).

B. ILLUSTRATIVE CLAIM

Claim 1 is exemplary and is reproduced below:

1. Apparatus for use in accessing sets of information stored in an information system, the apparatus comprising:

a computer having a user interface providing access to at least one information retrieval tool;

a computer store for recording data relating to information retrieval by users;

monitoring means operable, on receipt from a user at said user interface of one or more query terms for submission to said at least one information retrieval tool, to detect an indication by said user that a set of information identified by said at least one information retrieval tool using said received one or more query terms is relevant, and to record said received one or more query terms and an associated reference to said relevant set of information in said store;

weighting means arranged to calculate, in respect of every set of information referenced in said store, a weighting for every query term recorded in association with said referenced set of information, said weighting being indicative of the proportion of users who, upon using the recorded query term with said at least one information retrieval tool, indicated that said associated referenced set of information was relevant;

analysis means to identify a recorded query term for use with said at least one information retrieval tool, having, for each member of a group comprising one or more sets of information referenced in said store, a weighting in excess of a predetermined threshold; and

means for providing an information retrieval tool search result output obtained by use of said identified query term.

C. REJECTIONS

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Liddy	US 5,963,940	Oct. 05, 1999
Bowman	WO 99/45487	Sep. 10, 1999

Claims 1-16 stand rejected under 35 U.S.C. § 103(a) over the teachings of Liddy in view of Bowman.

II. ISSUE

The issue is whether Appellants have shown that the Examiner erred in finding that the combination of Liddy in view of Bowman teaches or would have suggested a means "arranged to calculate... a weighting" wherein "said weighting being indicative of the proportion of users" who "indicated that said associated referenced set of information was relevant" (claim 1).

III. FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Liddy

1. Liddy discloses presenting a set of documents to the user who is given an opportunity to select some or all of the documents, typically, on the basis of such documents being of particular relevance (Abstract).

Bowman

2. Bowman discloses generating a query result identifying a plurality of items that satisfy the query and allowing users to select an item from the query result (Abstract).
3. A ranking value is produced for a least a portion of the items identified in the query result by combining the relative frequencies with which users selected that item from the query results generated from queries specifying each of the terms specified by the query (*Id.*).

PRINCIPLES OF LAW

The *claims* measure the invention. *See SRI Int'l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (en banc). "[T]he PTO gives claims their 'broadest reasonable interpretation.'" *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)).

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said

subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007).

The Supreme Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id* at 1739. The operative question is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at 1740.

The Court noted that "[c]ommon sense teaches . . . that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle." *Id.* at 1742. "A person of ordinary skill is also a person of ordinary creativity, not an automaton." *Id.*

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

V. ANALYSIS

Combinability under 35 U.S.C. §103

The Examiner finds that one of ordinary skill in the art would have found it obvious to combine the teachings of Liddy and Bowman, as set forth beginning at page 6 of the Answer, which comply with the requirements of the above-noted case law. Appellants provide no argument to dispute that the Examiner has correctly shown that it would have been obvious to combine the references. Thus, we deem those arguments waived.

Elements under 35 U.S.C. §103

Appellants do not provide separate arguments with respect to the rejection of claims 1-16. Therefore, we select independent claim 1 as being representative of the cited claims. 37 C.F.R. § 41.37(c)(1)(vii).

Appellants argue that "[n]either Bowen et al. nor Liddy et al. teach or suggest that 'said weighting being indicative of the proportion of users who, upon using the recorded query term with said at least one information retrieval tool, indicated that said associated reference set of information was relevant' as expressly required in claim 1" (Br. 15) . In particular, Appellants contend that "nowhere does the cited passage of Bowman indicate that users actually identify whether the reference set of information was relevant" (Br. 17). Further, Appellants contend that the references "do not teach or suggest calculating the proportion of users who indicated that the retrieved information was relevant" (Br. 18).

Appellants appear to be arguing that *individually* Liddy and Bowman do not disclose the claimed invention. However, the Examiner has rejected the claims based on the combination of Liddy and Bowman, and nonobviousness cannot be shown by attacking the references individually. *See In re Merck* at 1097. In particular, the Examiner finds that "[t]he *combination* of Liddy in view of Bowman does disclose[sic] that users indicated that referenced set of information was relevant" (Ans. 13, emphasis added) and that "[t]he *combination* of Liddy in view of Bowman does disclose calculating the proportion of users who indicated that the retrieved information was relevant" (*Id.*, emphasis added).

Furthermore, though Appellants contend that the cited references "do not teach or suggest calculating the proportion of users who indicated that the retrieved information was relevant" (Br. 18), such argument is not commensurate in scope with the language of claim 1. That is, claim 1 does not recite any such "calculating the proportion of users" as Appellants contend. Instead, claim 1 merely recites "weighing means *arranged* to calculate… a weighting…, said weighting *being indicative* of the proportion of user." Thus, we will not read such "calculating the proportion of users" into claim 1.

Accordingly, we address on this appeal whether Appellants have shown that the Examiner erred in finding that the *combined* teachings of Liddy in view of Bowman teach or would have suggested a means "arranged to calculate… a weighting" wherein "said weighting being indicative of the proportion of users" who "indicated that said associated referenced set of information was relevant," as specifically claimed in claim 1.

We begin our analysis by giving the claims their broadest reasonable interpretation. *See In re Bigio*, 381 F.3d at 1324. Furthermore, our analysis will not read limitations into the claims from the specification. *See In re Van Geuns*, 988 F.2d at 1184.

Claim 1 simply does not place any limitation on what "being indicative" means, includes, or represents, other than that the weighting "being indicative" of the "proportion of users who… indicated that said associated referenced set of information was relevant." Therefore, we will not confine the meaning of "being indicative of the proportion of users" to the step of "calculating the proportion of users" as contended in Appellants'

arguments (Br. 18). Rather, we interpret the weighting "being indicative of the proportion of users" as a weighting that is related to the proportion of users.

Liddy discloses that a user is given an opportunity to select documents on the basis of such documents being of particular relevance (FF 1). We find that a skilled artisan would have understood Liddy to teach that users actually indicate whether a set of information was relevant. That is, contrary to Appellants' apparent argument that *individually* Bowman does not "indicate that users actually identify whether the reference set of information was relevant," as set forth by the Examiner, Liddy does disclose such teaching. Thus, the *combined* teachings of Liddy and Bowman do disclose the claimed "users" who "indicated that said associated referenced set of information was relevant" as set forth in claim 1.

Further, Bowman discloses that users indicate whether an item is selected from the query result (FF 2) and calculating a ranking value for a portion of the items identified in the query result by combining the relative frequencies with which users selected that item from the query results generated from queries specifying each of the terms specified by the query (FF 3).

A skilled artisan would have understood such calculating of a ranking value to be calculating a weighting for each term specified in the query. Further, the artisan would also have understood that such ranking value that is related to the portion of items selected by users to be a weighting that is "indicative" of the proportion of users who indicated that the items was selected. That is, the artisan would have understood that a portion or

proportion of items being selected by users would be related to or "indicative" of the portion or proportion of users who indicated that the items were selected.

Accordingly, we agree with the Examiner that the combination of Liddy and Bowman teaches and at the least would have suggested a means "arranged to calculate... a weighting" wherein "said weighting being indicative of the proportion of users" who "indicated that said associated referenced set of information was relevant," as recited in claim 1. That is, we find that Appellants' invention is simply an arrangement of adding the known teaching of calculating a value indicative of the proportion of users who indicated that a set of information was selected to the known teaching of users indicating that a set of information is selected as being relevant. A skilled artisan would have found it obvious to apply Liddy's teaching of users indicating that a set of information was selected as relevant to Bowman's teaching of calculating a weighting value indicative of the proportion of users who indicated that a set of information was selected. Thus, it is our view that a person of ordinary skill would have been able to fit such teachings of Liddy and Bowman together like pieces of a puzzle since a person of ordinary skill is also a person of ordinary creativity, not an automaton. *See KSR* at 1742.

Accordingly, we conclude that Appellants have not shown that the Examiner erred in rejecting claim 1 and claims 2-16 depending therefrom, under 35 U.S.C. § 103(a).

CONCLUSION OF LAW

(1) Appellants have not shown that the Examiner erred in finding that claims 1-16 are unpatentable over the teachings of Gillis and Bowman.

(2) Claims 1-16 are not patentable.

DECISION

The Examiner's rejection of claims 1-16 under 35 U.S.C. § 103(a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

peb

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